

REMARKS

This is a full and timely response to the outstanding final Office Action mailed October 23, 2006. Through this response, claims 1, 4-6, 11, 14-17, 19-23, 25, 27, and 29 have been amended, and claims 32-57 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-31 are respectfully requested.

I. Claim Objections

Claims 11, 15, and 16 have been objected to for various informalities. Specifically, referring to claim 11, the Office Action recommends that the phrase “the user a second genre is presented to the user” be changed to “a second genre is presented to the user.” Referring to claims 15 and 16, the Office Action notes that the phrase “the at least one archive screen” lacks antecedent basis. The claims depend on claim 6, which recites “an archive screen.” The Office Action recommends that the phrase of claim 15 be changed to “the archive screen.”

In response to the objection, Applicants have amended claims 11, 15, and 16. In view of the above-noted claim amendments, Applicants respectfully submit that the claims are not objectionable and respectfully request that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1, 4-17, 19-25, 27, 29, 30, 32, 42-49, and 51-57 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Hassell et al.* ("Hassell," U.S. Publication No. 2004/0128685). Applicants have canceled claims 32-57, thus rendering the rejection moot as to these claims. Further, Applicants respectfully traverse this rejection as applied to pending claims 1, 4-17, 19-25, 27, 29, and 30.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Hassell* reference. Applicants discuss the *Hassell* reference and Applicants' claims in the following.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
a memory for storing recordable media content characterizing information;
a storage device capable of storing on a plurality of portable storage mediums of a plurality of different portable storage medium types; and
a processor configured with the memory to:

receive into the memory characterizing information corresponding to respective recordable media content;
provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;
download the first recordable media content via the subscriber network from a server responsive to a first user input selecting the first recordable media content from the user interface;
select without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content; and
store into at least one of the plurality of portable storage mediums the downloaded first recordable media content, the at least one of the plurality of portable storage mediums corresponding to the media type of the first recordable media content.

Applicants respectfully submit that the rejection to claim 1 has been rendered moot. Additionally, Applicants respectfully submit that *Hassell* fails to disclose, teach, or suggest at least the above-emphasized claim features. The Advisory Action (page 2, paragraph 3) alleges:

Hassell et al. discloses . . . that a user may transfer programs stored on digital storage device 49 to other volumes of digital storage device 49 or to secondary storage device 47 (p. 8, paragraph 81). The program guide then transfers the programs and associated data (if possible) in an appropriate format to secondary program data storage device 47. Transferring the data associated with a program may not be possible with some analog secondary storage devices, so the program guide accordingly ignores the associated data transfer (p. 8, paragraph 83). Since the program guide deems the digitally stored program to be suitable for conversion and storage, whereas the associated data is not, the examiner concludes that this functionality also meets the limitation of a processor configured to “determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content,” as currently claimed.

Applicants respectfully disagree. Applicants respectfully submit that *Hassell* fails to

disclose, teach, or suggest the claimed features of “select without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content,” because *Hassell* fails to disclose teach or suggest a system having a plurality of portable storage medium types. Indeed, Applicants have reviewed the entirety of *Hassell* and have not found any disclosure of more than one secondary storage device.

In paragraphs 82 and 83, *Hassell* discloses:

[0082] . . . The program guide then transfers the programs and associated data (if possible) in an appropriate format to **secondary program data storage device 47**. If, for example, secondary storage device 47 is a videocassette recorder, the program guide directs user television equipment 22 to convert the digitally stored program or super-program into an appropriate analog format.

[0083] Transferring the data (e.g., software) associated with a program or super-program may not be possible with some analog secondary storage devices, so the program guide may accordingly ignore the associated data during transfer. The program guide may, however, provide for the labeling of analog storage media with associated data. Program guides that provide for labeling videocassettes with program information are described, for example, in Blackwell U.S. patent application Ser. No. 08/924,813, which is hereby incorporated by reference herein in its entirety.

Applicants will first assume *arguendo*, that the secondary storage device in *Hassell* corresponds to a portable storage medium. Even so, while it appears that *Hassell* discloses a number of different types of secondary storage devices that may be used to store content in a given system, *Hassell* fails to disclose that there may be a plurality of secondary storage devices (or portable storage mediums) in the same

system. Thus for at least this reason, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Applicants will further, assume *arguendo* that the system in *Hassell* has more than one secondary storage device. Even so, *Hassell* fails to disclose, teach, or suggest the claimed feature of “select[ing] without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content.” Merely determining the type of secondary storage device (for example, an analog videocassette recorder) and then recording content according to the limits of the device is simply not the same as “select[ing] without user intervention, a portable storage medium type. . . . from the plurality of different of portable storage medium types.” Thus, for at least this additional reason, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Because independent claim 1 is allowable over *Hassell*, dependent claims 4-17, 19-25, 27, 29, and 30 are allowable as a matter of law for at least the reason that the dependent claims 4-17, 19-25, 27, 29, and 30 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims

Claims 2, 26, 33-35, 37, and 50 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *LaJoie et al.* (“*LaJoie*,”

U.S. Pat. No. 5,850,218). Claims 3 and 36 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *LaJoie* and in further view of *Lewis* (“*Lewis*,” U.S. Publication No. 2003/0040962). Claim 18 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* with a taking of Official Notice. Claim 28 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Browne, et al.* (“*Browne*,” U.S. Publication No. WO 92/22983). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Russo* (“*Russo*,” U.S. Pat. No. 5,619,247). Claims 38-41 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Lewis*. To the extent that cancellation of the claims has not rendered the rejections moot, Applicants respectfully traverse these rejections.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Dependent Claims 2, 26, 33-35, 37, and 50

The Office Action rejected claims 2, 26, 33-35, 37, and 50 under *Hassell* in view *LaJoie*. The cancellation of claims 32-57 has rendered the rejection of claims 33-35, 37, and 50 moot. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *LaJoie* fails to remedy these deficiencies. At least for the reason that claims 2 and 26 incorporate the allowable features of claim 1, Applicants respectfully submit that claims 2 and 26 are allowable as a matter of law.

Dependent Claims 3 and 36

The Office Action rejected claims 3 and 36 under *Hassell* in view *LaJoie* and in further view of *Lewis*. The cancellation of claim 36 has rendered the rejection of claim 36 moot. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *LaJoie* and *Lewis* fail to remedy these deficiencies. At least for the reason that claim 3 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 3 is allowable as a matter of law.

Dependent Claim 18

The Office Action rejected claim 18 under *Hassell* with a taking of Official Notice. As explained above, *Hassell* fails to disclose, teach, or suggest at least

the above-emphasized features of claim 1. Applicants respectfully submit that the taking of Official Notice fails to remedy these deficiencies. At least for the reason that claim 18 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 18 is allowable as a matter of law.

Dependent Claim 28

The Office Action rejected claim 28 under *Hassell* in view of *Browne*. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *Browne* fails to remedy these deficiencies. At least for the reason that claim 28 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 28 is allowable as a matter of law.

Dependent Claim 31

The Office Action rejected claim 31 under *Hassell* in view of *Russo*. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *Russo* fails to remedy these deficiencies. At least for the reason that claim 31 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 31 is allowable as a matter of law.

Dependent Claims 38-41

The cancellation of claims 38-41 has rendered the rejection of claims 38-41 moot.

IV. Official Notice

The Office Action has made the following allegations of Official Notice and well-known use (location in the Office Action and claim relevance noted in parenthesis):

(Page 14, pertaining to claim 18) . . .the examiner takes Official Notice that it is notoriously well known within the prior art to distribute content from a server to a single client in response to that client's request for content.

The Advisory Action (page 2, paragraph 4) alleges:

Regarding claim 18, the applicant argues that the distribution of content from a server to a single client through an exclusive network session is not notoriously well-known in the art, as asserted by the examiner's Official Notice. The examiner respectfully disagrees. In further support of the assertion, the examiner directs the applicant to the previously cited La Joie et al. reference. La Joie et al. discloses transmitting programs to a subscriber's set-top terminal in the form of a unicast (unicast is the sending of information packets to a single destination see <http://www.dictionary.com/encyclopedia/edition-of/unicast>) transmission (col. 9, l. 43-52). Thus, the examiner maintains that it is notoriously well-known in the art to send media content from a server to a user through an exclusive network session, as previously asserted.

Applicants respectfully traverse these findings of well-known or Official Notice and submit that the subject matter pertaining to these claims should not be considered well-known. Applicants respectfully submit that such a disclosure in the references does not constitute the characterization of being "notoriously well-known." Accordingly, Applicants traverse the assertions with regard to well-known use, and respectfully request that the Office support its findings, with evidence, or withdraw the alleged well-known finding.

V. Canceled Claims

As identified above, claims 32-57 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/Karen G. Hazzah/

Karen G. Hazzah
Registration No. 48,472

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500